

REMARKS

I. STATUS OF CLAIMS

Claims 121, 132, 137, 143, 144, 147, 153, 157, 158, 161, 166, 169, 170, 172, 177-180, 183, 218, 219, 221, and 223 are pending in this application. Claim 132 is amended. The specification and claims provide written description support for this claim amendment. Accordingly, no new matter is added by the amendments provided herein, and their entry is respectfully requested.

II. STATEMENT OF SUBSTANCE OF EXAMINER INTERVIEW

Applicants thank Examiner Venkat for the courtesies she extended to Applicants' undersigned representatives on April 27, 2009, and August 3, 2009, discussing the present application. The Substance of Interview that is included in the Interview Summary mailed May 7, 2009, accurately reflects our discussions on April 27, 2009. Likewise, the Interview Summary mailed August 25, 2009, accurately reflects our continued discussions on August 3, 2009. As a result of those discussions and a further study of the case, Applicants file this Amendment and Reply.

III. REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 121, 132, 137, 143, 144, 147, 153, 157, 158, 161, 166, 169, 170, 172, 177-180, 183, 218, 219, 221 and 223 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Office Action at pp. 2-8. Specifically, the Examiner asserts that "[t]here is no support in the specification for claims drawn to the species belonging to structuring polymer, which is "ethylenediamine/stearyl dimer tallate copolymer". *Id.* at p. 2.

In addition, the Examiner asserts that "[t]here is no support in the specification for claim 132 drawn to structuring polymer in the form of mixture of polymers." *Id.* at p. 8.

With respect to claim 132, to advance prosecution Applicants have amended claim 132 to read, "wherein the at least one structuring polymer comprises ethylenediamine/stearyl dimer dilinoleate copolymer and ethylenediamine/stearyl dimer tallate copolymer." The specification and claims provide written description support for this claim amendment. Specifically, page 4, lines 4-8 of the specification describes one aspect of the invention, which is drawn to an anhydrous composition comprising "at least one structuring polymer." "At least one structuring polymer," can include more than one structuring polymer, *e.g.*, a mixture of two structuring polymers. Thus, despite the Examiner's assertion, the specification provides written description support for a structuring polymer in the form of a mixture of polymers, *e.g.*, a mixture of ethylenediamine/stearyl dimer dilinoleate copolymer and ethylenediamine/stearyl dimer tallate copolymer.

In addition, Applicants continue to disagree with the Examiner's assertion that there is no support in the specification for the ethylenediamine/stearyl dimer tallate copolymer; Applicants maintain that one of ordinary skill would have known that ethylenediamine/stearyl dimer tallate copolymer was known by the trade name Uniclear[®], as set forth in the specification, at the time the application was filed.

According to the International Cosmetic Ingredient Dictionary and Handbook, page 606, 9th ed. (2002), ethylenediamine/stearyl dimer tallate copolymer, which has the tradename Uniclear, is a copolymer of ethylenediamine and tall oil dimer acid monomers end blocked with stearyl alcohol. Applicants submit that written description

for this copolymer can be found in the original specification at least at page 15, lines 3-13, which states that:

Non-limiting examples of at least one polyamide polymer may be used in the composition according to the present invention include commercial products sold by Arizona Chemical under the names Uniclear 80 and Uniclear 100. These are sold, respectively, in the form of an 80% (in terms of active material) gel in a mineral oil and a 100% (in terms of active material) gel. These polymers have a softening point from 88 to 94°C, and may be mixtures of copolymers derived from monomers of (i) C₃₆ diacids and (ii) ethylene diamine, and have a weight-average molecular mass of about 6000. Terminal ester groups result from the esterification of the remaining acid end groups and at least one alcohol chosen from cetyl alcohol and stearyl alcohol. A mixture of cetyl and stearyl alcohols is sometimes called cetylstearyl alcohol.

(emphasis added).

As the Examiner points out on pages 3-4 of the Office Action, the above description in the specification teaches species that can be formed from:

(i) C36 diacids and ethylenediamine and the terminal ester groups result from esterification of the remaining acid end groups can be with cetyl alcohol or the species can be formed from (ii) C36 diacids and ethylene diamine and the terminal ester groups result from esterification of the remaining acid ***end groups can be with stearyl alcohol or*** the species can be formed from [(iii)] C36 diacids and ethylenediamine and the terminal ester groups result from esterification of the remaining acid end groups can be with a mixture of cetyl and ***stearyl alcohols*** also known as cetylstearyl alcohol.

(emphasis added). This description readily conveys a copolymer of ethylenediamine and tall oil dimer acid monomers end blocked with stearyl alcohol such as the ethylenediamine/stearyl dimer tallate copolymer recited in independent claims 121, 161, 218, 219, 221 and 223.

In addition, Applicants submit herewith as Exhibit 1, a redacted copy of an Expert Report of Robert Lochhead, Ph.D., submitted on December 15, 2006, in *L'Oréal S.A. v. Estée Lauder Co.*, Civil Action No. 04-1660 (HAA) (D.N.J. filed Apr. 7, 2004), and as Exhibit 2, a letter from the Cosmetic Toiletry and Fragrance Association ("CFTA") dated December 14, 1999, and relied upon in the Expert Report. At paragraph 14 of his report, Dr. Lochhead states that persons skilled in the art reading the disclosure regarding Uniclear® in the specification of the patent at issue (which corresponds to the present specification) would have understood that the inventors contemplated use of ethylenediamine/stearyl dimer tallate copolymer as a structuring polymer. Applicants submit that the teachings provided in the information already of record, as well as the teachings provided by the additional evidence submitted herewith, establish that the ethylenediamine/stearyl dimer tallate copolymer was known by those of ordinary skill as Uniclear® at the time of filing of the present application, December 28, 2000.

Moreover, a trademarked product may cover a range of products containing the same copolymer family, but having different concentrations, in different solvents or with different additives, leading to different physicochemical properties. As mentioned in the specification, Uniclear 80 and Uniclear 100 have different formulations. For example, Uniclear 80 and Uniclear 100 contain different concentrations of active material. Such difference in concentrations may explain the different softening points discussed by the Examiner at page 7 of the Office Action.

In summary, the specification describes the copolymers known as Uniclear® and demonstrates that Uniclear® is the trade name for ethylenediamine/stearyl dimer tallate copolymer. Moreover, the CFTA's December 14, 1999, letter and Dr. Lochhead's

Expert Report, which relies upon the CFTA's letter, which is submitted herewith, is further evidence that the ethylenediamine/stearyl dimer tallate copolymer was known by those of ordinary skill as Uniclear[®] at the time of filing of the present application, December 28, 2000. Accordingly, Applicants submit independent claims 121, 161, 218, 219, 221 and 223, and the claims that depend therefrom, are fully supported by the specification as filed.

In view of the foregoing, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

IV. REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claim 132 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Office Action at p. 8. The Examiner asserts that claim 132 lacks antecedent basis since claim 131 recites species and claim 132 recites mixtures of polymers.¹

Applicants respectfully disagree with the Examiner's rejection. However, to advance prosecution, Applicants amended claim 132 as discussed in Section III above. Applicants submit that claim 132, as amended, is clear and definite. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection.

V. REJECTIONS UNDER 35 U.S.C. § 103

Claims 121, 132, 137, 143, 144, 147, 153, 157, 158, 161, 166, 169, 170, 177-180, 183, 218, 219, 221, and 223 are rejected under 35 U.S.C. § 103 as allegedly being

¹ We note that claim 132 depends from claim 121, not claim 131, as asserted by the Examiner.

unpatentable over the combination of U.S. Patent No. 5,783,657 to Pavlin et al.

("Pavlin") and U.S. Patent No. 6,019,962 to Rabe et al. ("Rabe"). Office Action at p. 8.

In addition, claim 172 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of Pavlin in view of Rabe, and further in view of U.S. Patent No. 4,699,924 to Durrant et al. ("Durrant"). *Id.* at p. 12.

Each of independent claims 121, 161, 218, 219, 221 and 223, comprise, *inter alia*, "at least one structuring polymer chosen from ethylene/stearyl dimer diinoleate copolymer and ethylenediamine/stearyl dimer tallate copolymer." Pavlin, on the other hand, only teaches a composition comprising a polyamide of formula (I), encompassing thousands, if not millions, of possible structuring polymers to try.

"The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness." M.P.E.P. §2144.08 (citing *In re Baird*, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) ("The fact that a claimed compound may be encompassed by a disclosed generic formula does not render the compound obvious."). While Pavlin discloses an ester-terminated polyamide (ETPA) of formula (I), there is no disclosure of the claimed species of structuring polymers, e.g., Uniclear, recited in independent claims 121, 161, 218, 219, 221 and 223. Moreover, there is no teaching or suggestion in Pavlin that would direct one of ordinary skill in the art to choose Uniclear rather than one of the other structuring polymers encompassed by formula (I). In fact, Pavlin would direct one of ordinary skill in the art away from Uniclear.

Uniclear is derived from the condensation polymerization of: about 76.62 wt% of a dimer acid (Empol 1011), about 5.87 wt% of an amine (ethylene diamine), and about

17.51 wt% of an alcohol (Alfol-18, i.e., stearyl alcohol).² See Information Relevant to the Use and Availability of UNICLEAR 80/100, attached herewith as Exhibit 3. From a review of Pavlin, the closest ester-terminated polyamide (ETPA) to Uniclear is Example 8. See Pavlin, col. 20, line 55 to col. 21, line 14. Example 8 is an ETPA derived from 76.4 wt% of the dimer acid Empol 1008, 5.9 wt% of ethylene diamine, and 19.7 wt% of stearyl alcohol. See *id.* Example 8, however, reports that gels formed from this Uniclear-like structurant made from 19.7 wt% stearyl alcohol were opaque, not clear. See *id.* at col. 21, lines 12-14. Further, Example 8 warns that "[t]his example shows that there is a lower limit to the alcohol concentration that can be used in an ETPA, and still obtain a transparent gel therefrom." See *id.* at col. 20, lines 60-62. In view of the fact that Uniclear is an ETPA that is derived from only about 17.51 wt% stearyl alcohol, it is below the lower limit taught by Pavlin for making clear gels. Accordingly, a person of ordinary skill in the art would have been directed away from using Uniclear as the structuring polymer by this disclosure in Pavlin.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See M.P.E.P. § 2141.02(VI). Indeed, the totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is "strong evidence of unobviousness." *In re Hedges*, 783 F.2d 1038, 1041, 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986). When the disclosure of Pavlin is considered in its entirety, as required, see M.P.E.P. § 2141.02(VI), a person would have been directed away from Uniclear by Pavlin teaching that a stearyl alcohol

² Alfol-18 is a trademark for stearyl alcohol. See International Cosmetic Ingredient Dictionary and Handbook 1654 (9th ed. 2002), submitted herewith as Exhibit 4.

concentration of 19.7 wt% or below in an ETPA would form an undesirable opaque gel. This teaching away in Pavlin would have led one of ordinary skill in the art to other disclosed ETPA structuring polymers with a stearyl alcohol concentration of greater than 19.7 wt%. Thus, common sense would dictate against both selection and addition of Uniclear from among the other ETPA structuring polymer disclosed in Pavlin.

Rabe and Durrant do not rectify the deficiencies of Pavlin discussed above. Thus, Applicants submit that the Examiner failed to establish a *prima facie* case of obviousness over Pavlin and Rabe, alone, or in combination with, Durrant. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw each of the foregoing rejections.

VI. OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS

The Examiner rejects the pending claims under the judicially-created doctrine of obviousness-type double patenting on twelve different grounds:

Claims 121, 161, 218, 221 and 223 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-4 of U.S. Patent No. 6,716,420 to Feng et al. ("the '420 patent") in view of Rabe;

Claims 121, 161, 218, 221 and 223 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 3 of U.S. Patent No. 6,835,399 to Collin ("the '399 patent");

Claims 121, 161, 218, 221 and 223 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 2 of U.S. Patent No. 6,869,594 to Ferrari ("the '594 patent");

Claims 121, 161, 218, 221 and 223 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claim 1 of U.S. Patent No. 6,881,400 to Collin ("the '400 patent");

Claims 121, 161, 218, 221 and 223 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 7 of U.S. Patent No. 6,979,469 to Ferrari et al. ("the '469 patent");

Claims 121, 161, 218, 221 and 223 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 2 of U.S. Patent No. 7,008,619 to Kanji ("the '619 patent").

Claims 121 and 161 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 24 and 27 of U.S. Patent No. 7,008,629 to Kanji ("the '629 patent");

Claim 223 is rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 7 of U.S. Patent No. 7,011,823 to Ferrari et al. ("the '823 patent");

Claims 121 and 161 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claim 1 of U.S. Patent No. 7,052,681 to Ferrari ("the '681 patent");

Claims 121 and 161 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claim 1 of U.S. Patent No. 7,276,547 to Pinzon et al. ("the '547 patent");

Claims 121, 161, and 218 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 19-21, 28 and 29 of U.S. Patent No. 7,314,612 to Ferrari et al. ("the '612 patent"); and

Claim 218 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claim 31 of U.S. Patent No. 7,410,636 to Collin ("the '636 patent").

Office Action at pp. 14-30.

Applicants presently agree with the double patenting rejections and plan to file an appropriate Terminal Disclaimer when allowable subject matter for the presently pending claims is indicated.

VII. COMMONLY ASSIGNED CO-PENDING APPLICATIONS AND PATENTS

In previous submissions, Applicants noted information regarding co-pending applications and patents, including the present application, and submitted copies of the pending claims as of the date of those submissions for every case identified. Applicants submit herewith, as Exhibit 5, a copy of the pending and/or issued claims of Application Nos. 10/450,108, 09/733,899, and 09/733,900, which have been amended or issued since May 19, 2008. Applicants submit those claims for the Office's convenience in evaluating any potential issues regarding statutory or obviousness-type double patenting.

VIII. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: September 2, 2009

By: Jennifer R. Gupta
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Attachments:

- Exhibit 1** - Expert Report of Robert Lochhead, Ph.D., submitted on December 15, 2006, in L'Oréal S.A. v. Estée Lauder Co., Civil Action No. 04-1660 (HAA) (D.N.J. filed Apr. 7, 2004);
- Exhibit 2** - Letter from the Cosmetic Toiletry and Fragrance Association ("CTFA") dated December 14, 1999;
- Exhibit 3** - Information Relevant to the Use and Availability of UNICLEAR 80/100;
- Exhibit 4** - International Cosmetic Ingredient Dictionary and Handbook ("CTFA") 9th ed., p. 1654 (2002); and
- Exhibit 5** - 3 Sets of Claims from Co-Pending Applications